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11/27/09

*In re* Application of:  
FORSBERG, JOHN W. et al  
Serial No.: 10/693,005  
Filed: Oct. 24, 2003  
Docket: 1023-294US01  
Title: MEDICAL DEVICE PROGRAMMER  
WITH INFRARED COMMUNICATION

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: DECISION ON PETITION  
: under 37 CFR 1.181  
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This is a decision on the petition filed on November 23, 2009 filed under 37 CFR 1.181 seeking to have the rejection of the dependent claim 15 in the Supplemental Examiner's Answer mailed on September 23, 2009 be designated as a new ground of rejection.

The petition is being considered pursuant to 37 CFR 1.181 and no fee is required.

The petition is DISMISSED.

The following relevant facts include:

1. Pursuant to the petition decision mailed on June 18, 2009, a Supplemental Examiner's Answer was mailed on September 23, 2009 to remove the objection of the examiner's reference to the example devices of Samsung SCH-u740 cellular telephone and the Palm Centro device. In the Supplemental Examiner's Answer, on page
2. In response to the Supplemental Examiner Answer of September 23, 2009, the applicant filed a Reply Brief. In the Reply Brief, the applicant addressed and answered all of the examiner's arguments as stated under the "Response to Argument" of the Supplemental Examiner's Answer. In particular, the applicant questioned the examiner's arguments regarding the dependent claim 15. The applicant also indicated that the examiner's arguments regarding claim 15 constitutes new ground of rejection.

3. On November 23, 2009, the applicant filed the current petition arguing that the examiner has improperly introduced a new ground of rejection in the Supplemental Examiner's Answer of September 23, 2009. The applicant is requesting the rejection of dependent claim 15 of the Supplemental Examiner's Answer to be designated as new ground of rejection. In the petition, the applicant argues that the bottom paragraph of page 19 of the Supplemental Examiner's Answer, the statement "Removal of the battery cover of such a cell phone clearly reveals that the antenna extends into the battery bay." is based on the examiner's personal knowledge. Therefore, the rejection of dependent claim 15 must be designated as a new ground of rejection.

#### Discussion and Analysis

A review of the final rejection of March 21, 2008 and the Supplemental Examiner's Answer of September 23, 2009 shows there is no new ground of rejection at all. In the petition, petitioner argues that the examiner's rebuttal statement "Removal of the battery cover of such a cell phone clearly reveals that the antenna extends into the battery bay." is based on the examiner's personal knowledge. Petitioner questions whether "such a cell phone" is based on the examiner's own knowledge so that an affidavit should be obtained from the examiner. Therefore, the rejection of dependent claim 15 must be designated as a new ground of rejection. However, a careful study of the final rejection of March 21, 2008 and the Supplemental Examiner Answer of September 23, 2009 does show that the rejection of claim 14 was based on the obvious matter of design choice with an example "such as cellular phone". Since claim 15 is dependent upon claim 14, the examiner, in his rebuttal argument at the bottom paragraph of page 19 of the Supplemental Examiner's Answer, apparently referred to the same cell phone of the rejection of claim 14.

The Supplemental Examiner's of September 23, 2009 simply does not show any new grounds of rejection. It should be noted that there is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. It is further noted that the applicant has filed a Reply Brief to fully rebut the examiner's rebuttal arguments in the Supplemental Examiner's Answer of September 23, 2009. The cell phone referred to at the bottom paragraph of page 19 of the Supplemental Examiner's Answer of September 23, 2009 regarding claim 15 appears to be referring to the rejection of claim 14 (see rejection of claim 14). The rejection of claims were never changed. Petitioner can not now argue that the applicant did not have an opportunity to argue and react to the rejections from March 21, 2008. If petitioner believes the first Office action or the final rejection was incomplete or unclear, petitioner should have brought to the examiner's attention in the first place.

The examiner's rebuttal arguments at the bottom paragraph of page 19 of the Supplemental Examiner's Answer do not alter the grounds of rejection presented in Section 9 of the Supplemental Examiner's Answer. In this case, the statutory basis for the rejection and the evidence relied upon in support of the rejection remained the same in the non-final rejection, the final rejection and the Supplemental Examiner's Answer. In such a circumstance, a change in the discussion of, or rationale in support of, a change of arguments, if any, the examiner's rebuttal arguments do not necessarily constitute a new

ground of rejection. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425,426-27 (CCPA 1976); MPEP § 1207.03III<sup>1</sup>. Petitioner should also note that even if the suggestion to characterize the examiner's rebuttal arguments in the Supplemental Examiner's Answer of September 23, 2009 as new ground of rejection were persuasive, which it is not, the appellant still would have had a fair opportunity to react to these rebuttal arguments in the Reply Brief as permitted under 37 CFR 41.41(a) (1). In this case, the applicant in fact did file a Reply Brief to react to the examiner's rebuttal arguments on November 23, 2009. A fair opportunity to react to the examiner's rebuttal arguments was already provided.

### Conclusion

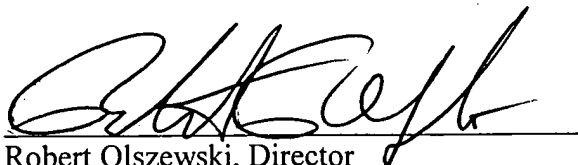
For the foregoing reasons, the relief requested by petitioners will not be granted. Specifically, the requested designation of the rejection of dependent claim 15 as new ground of rejection in the Supplemental Examiner's Answer of September 23, 2009 can not be granted.

The application is being returned to the examiner via the Supervisory Patent Examiner of Art Unit 3762 for consideration of the Reply Brief filed on November 23, 2009 and forward to the Board of Appeals and Interference for decision.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181."

Any inquiry regarding this decision should be directed to Henry Yuen, Special Program Examiner, at (571) 272-4856.

The petition is dismissed.



Robert Olszewski, Director  
Technology Center 3700

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<sup>1</sup> MPEP 1207.03 III states in pertinent part: There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. Id. at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a new ground of rejection).